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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Alan Lippman

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EXAMINER

TODD, GREGORY G

ART UNIT

PAPER NUMBER

2457

NOTIFICATION DATE

DELIVERY MODE

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ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PatentDocketingUS-PaloAlto@dlapiper.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/625,764	<b>Applicant(s)</b> LIPPMAN ET AL.	
	<b>Examiner</b> GREGORY G. TODD	<b>Art Unit</b> 2457	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to applicant's amendment and request for continued examination filed, 06 May 2009, of application filed, with the above serial number, on 22 July 2003 in which claims 1, 2, and 15 have been amended. Claims 1-20 are pending in the application.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. The claim scope is undetermined as a reasonable interpretation of the system claims can refer to embodiments which are just software.

In order to expedite a comprehensive examination of the instant application, the claims rejected under 35 U.S.C.101 (non-statutory) above, are further rejected as set forth below in anticipation of applicant amending these claims to place them within the admissible statutory categories of invention.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended so that the 'local application having an instruction that generates a request for access to a local resource' *rather* than the initiating program. However, the 'translator program that receives the access request from the initiating program' still recites the request coming from the *initiating* program. It is not clear as to the request source.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Reisman (hereinafter "Reisman", 6,658,464).

As per Claim 1, Reisman teaches a computer-implemented local resource access system, comprising:

an initiating program that has a link to access a local resource (at least col. 36:21-49; local browser with 'active' hyperlinks of local content);

a local application having an instruction that generates a request for access to a local resource based on the link to access the local resource, the request including a token and having the form of a hyperlink and wherein the local resource is not accessible directly from the initiating program (at least col. 36:22-37:32; also col. 52:35-53:54; link manager and relocater for browser hyperlink for local content); and

a translator program that receives the access request from the initiating program, the translator program further comprising instructions that generate a return token in response to the access request and instruction that return the return token to the initiating program, the return token further comprising a hyperlink containing a path to the local resource (at least col. 36 line 22 – col. 37 line 32; col. 43, lines 12-60; col. 45:49-50:24; link interceptor/ translator).

As per Claim 2. The system of claim 1, wherein the local application further comprises an instruction that receives the return token and an instruction that launches an application to execute the local resource pointed to by the return token (at least col. 36 line 22 – col. 37 line 48; col. 43, lines 25-47; eg. completion of calling link).

As per Claim 3. The system of claim 1, wherein the translator program further comprises a local application that is part of a media delivery system (at least col. 36 line 22 – col. 37 line 48; col. 43, lines 12-60).

As per Claim 4. The system of claim 3, wherein the translator program further comprises a local server that is part of a media delivery system (at least col. 36 line 22 – col. 37 line 48; col. 43, lines 12-60; server).

As per Claim 5. The system of claim 1, wherein the translator program further comprises a web page plug-in and wherein the initiating program further comprises a web page (at least col. 36 line 22 – col. 37 line 32; col. 43, lines 12-60; col. 44, lines 1-19; plugin, web pages).

As per Claim 6. The system of claim 1, wherein the initiating program further comprises an e-mail client application (at least col. 52, lines 33-67; email).

As per Claim 7. The system of claim 1, wherein the initiating program further comprises a messaging client application (at least col. 52, lines 33-67; email).

As per Claim 8. The system of claim 1, wherein the translator program further comprises an instruction that applies a network security policy to the return token wherein a validated return token is returned to the initiating program if the network security policy is satisfied (at least col. 44, lines 20-37; proxy server for security, firewall).

As per Claim 9. The system of claim 8, wherein the network security policy returns an error report if the network security policy is not satisfied (at least col. 44, lines 20-37; proxy server for security, firewall).

As per Claim 10. The system of claim 5, wherein the translator program further comprises an instruction that applies a network security policy to the return token wherein a validated return token is returned to the initiating program if the network security policy is satisfied (at least col. 44, lines 20-37; proxy server for security, firewall).

As per Claim 11. The system of claim 10, wherein the network security policy returns an error report if the network security policy is not satisfied (at least col. 44, lines 20-37; proxy server for security, firewall).

As per Claim 12. The system of claim 10, wherein the initiating program further comprises a java script that generates a hyperlink to the local resource if the validated return token is returned (at least col. 39, lines 30-48; col. 37, lines 1-48; java).

As per Claim 13. The system of claim 1, wherein the return token generation instruction further comprises an instruction for determining the type of hyperlink to be sent to the initiating program (at least col. 36 line 22 – col. 37 line 32; col. 43, lines 12-60; eg. filename).

As per Claim 14. The system of claim 13, wherein the type of hyperlink comprises one of a localhost link, a loopback link, a file link and a protocol link (at least col. 36 line 22 – col. 37 line 32; col. 43, lines 12-60; col. 45 line 65 – col. 46 line 24).

Claims 15-20 do not substantially add or define any additional limitations over claims 1-14 and therefore are rejected for similar reasons.

### ***Response to Arguments***

7. Applicant's arguments filed 06 May 2009 have been fully considered but they are not persuasive.

Applicant argues Reisman does not teach an initiating program claim element. Applicant argues Reisman requires a different browser from the 'typical web browser'.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., typical web browser) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Reisman teaches a web browser, and while, indeed, it is primarily used for offline browsing, Reisman's offline browser does still go online when needed (col. 37:14-21) and that the browser is indeed a normal browser, it would just be catered for use in offline mode (col. 34:17-35:36). Applicant also clearly specifies in Arguments (p. 5:20-22) that the initiating program is a web browser.

Further, Applicant's amendments have added another 'link' to the claims and the claims are vague in how the links/hyperlinks differ. The initiating program has a link to the local resource, while the local application generates a request having the form of a



hyperlink, and the translator program generates a return token comprising a path to the local resource. First, it is not clear if the link is different somehow than the hyperlink(s). Second, if they are the same, the initiating program has a link to access the local resource and is ultimately returned a hyperlink containing a path to the local resource. It is not clear, in the claims, if anything is really happening, or at the most, the 'access' does not contain the proper 'path'. Clarification is requested.

Applicant also argues Reisman does not teach a local application claim element having an instruction that generates a request for access to a local resource, the request including a token and having the form of a hyperlink and wherein the local resource is not accessible directly from the initiating program. However, Reisman, as discussed below with relation to the translator program, teaches that the initiating program (offline browser) cannot directly access the URL and must use translation to access the respective link (at least col. 43, lines 12-60). Further, as the disclosure suggests, an initiating program may also be email related, which Reisman also touches upon, retrieving email and then local resources can be linked to and used when the user is offline reading the email (see col. 52 line 35 - col. 53 line 65).

Applicant further argues Reisman does not teach a translator program claim element that receives the access request from the (initiating program?), the translator program further comprising instructions that generate a return token in response to the access request and instruction that return the return token to the initiating program, the return token further comprising a hyperlink containing a path to the local resource. However, Reisman clearly teaches a link interceptor and translator, which intercepts the

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initiating program's (in this case offline browser) link request, translates it, and passes the translation back to the offline browser for completion (at least col. 36 line 22 – col. 37 line 32; col. 43, lines 12-60; col. 45:49-50:24; link interceptor/ translator for coding links using extension such as “tsh”).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited Cianfrocca et al, in addition to previously cited Pallmann, Simpson et al, Bellotti et al, and Beged-Dov et al are cited for disclosing pertinent information related to the claimed invention. Applicants are requested to consider the prior art reference for relevant teachings when responding to this office action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY G. TODD whose telephone number is (571)272-4011. The examiner can normally be reached on Monday - Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. G. T./  
Examiner, Art Unit 2457

/ARIO ETIENNE/  
Supervisory Patent Examiner, Art Unit 2457